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09/332,298	06/11/1999	YASUSHI ABE	31812	2750

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EXAMINER

NGUYEN, NAM V

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/332,298

Applicant(s)

ABE, YASUSHI

Examiner

Nam V Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-6 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 7-14 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This communication is in response to applicant's response to Response "B" which is filed January 23, 2003.

Claims 1-28 are pending.

### ***Response to Arguments***

Applicant's argument with respect to the pending claims 1 and 15, filed January 23, 2002, are persuasive. Therefore the examiner has withdrawn the rejections.

Applicant's arguments to the rejected claims 7 and 21 are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C § 103(a) as discussed below. Applicant's arguments have been fully considered but they are not persuasive for at least the following reasons.

Regarding claims 7 and 21, on page 4, second paragraph, Applicant's arguments that there is no suggestion or motivation to modify the teachings of Vanden Heuvel in view of Helferich. Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a

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whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). Vanden Heuvel suggests that when a valid message received and it is a personal selective call message, the memory manager checks for an available memory slot. If no slot is available, the oldest read or oldest unread message is deleted and the next available personal control area slot is made available for message storage. This method would ensure effective utilization of the memory data area (column 9 lines 55 to column 10 lines 9; see Figure 9). Helferich teaches that erasing the messages after the messages have been checked by the user selection function.

On page 4, second paragraph, Applicant's arguments that in Helferich does not teach or suggest to deleting a message once it is checked by the user is not persuasive.

The pager transceiver of Helferich teaches that when a valid message received a selective call, the pager transceiver CPU determine whether an acknowledgment has been enabled. If the acknowledgment has been enabled, the acknowledgment flag is enabled (column 9 lines 58 to 67; see Figure 7). The pager transceiver CPU performs house keeping functions (column 10 lines 1 to 18). The user selects the functions to be performed from available functions such as retrieve, erase or save message (column 10 lines 19 to 30; see Figure 8). One of ordinary skilled in the art understand that a user select an erase function after the received message is read, the received message is marked in order for the pager transceiver CPU knows that a particular message is erased after the process function is performed. Therefore, Helferich teaches or suggests deleting a message once it is checked by the user.

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The examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8, 10 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanden Heuvel et al. (US# 5426,424) in view of Helferich (US# 6,259,892.)

Referring to claims 7 and 21, Vanden Heuvel et al. disclose a radio paging receiver (100) comprising:

Receiving means (103) for receiving a radio signal from a base station of a radio paging system (column 1 lines 11 to 15);

First decoding means (111) for picking up one calling address or a plurality of calling addresses assigned to own receiver from the radio signal received by the receiving means and also picking up message data corresponding to the calling address or the calling addresses (column 4 lines 48 to 52);

Data storing means (115) for storing the message data picked up by the first decoding means (column 4 lines 48 to 52);

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Holding means (109) for holding at least of calling address assigned to own receiver (column 4 lines 26 to 33);

Character sequence designating means (301) for designating character sequences in stored messages (column 5 lines 60 to 63);

Character sequence retrieving means (302) for detecting whether or not designated character sequences are contained in stored messages (column 4 lines 63 to 66);

Time counting means (113) for monitoring whether or not a predetermined time has lapsed after the messages are stored;

Erasing means (905 in Figure 9) for erasing the stored messages from a storage area (column 9 lines 65 to 68);

received character sequence retrieving means (1302 in Figure 13) for detecting whether or not designated character sequences are contained in received messages (column 11 lines 54 to 65). However, Vanden Heuvel et al. did not explicitly wherein when designated character sequences are contained in the received messages, the messages are not stored in a storage area but erased after the messages have been checked.

In the same field of endeavor of radio paging receiver, Helferich teaches that discloses wherein when designated character sequences (i.e. message identifier; see Figure 11) are contained in the received messages (201), the messages (201) are not stored in a storage area (5; see Figure 1) but erased after the messages have been checked (97) (i.e. ACK Flag; see Figures 7 and 8) (column 9 lines 58 to column 10 lines 44; column 11 lines 35 to 48; column 14 lines 6 to 23).

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At the time the invention, it would have been obvious to a person of ordinary skill in the art to recognize the need to set up an acknowledgment flag in the message identifier to be erased after the message is read as evidenced by Helferich in the selective call receiver of Vanden Heuvel et al. because erasing after the messages have been checked would improve the memory space of the selective call receiver and delete unimportant message when the user flags the received message.

Referring to claim 8, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to claim 7, Vanden Heuvel et al. disclose further comprising character sequence inputting means for inputting character sequences which are retrieved to erase messages (column 12 line 65 to column 12 line 4.)

Referring to claim 22, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to claim 21, Vanden Heuvel et al. disclose further comprising a character sequence inputting means (503 in Figure 5 or 6) for inputting character sequences which are retrieved to erase message (column 6 lines 59 to 65).

Referring to claim 23, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to claims 21, Vanden Heuvel et al. disclose further comprising:

Address associated storing means (601) for storing the message data picked up by the first decoding means every calling address (column 8 line 68 to column 9 line 5);

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Address setting means (701) for designating the calling addresses as objects of erasure by time counting (column 9 lines 21 to 36); and

Second controlling means (120) for causing the erasing means to erase the messages based on signals from the address setting means and the time counting means (column 5 lines 19 to 27).

Referring to claims 10 and 24, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to claims 7 and 21, Vanden Heuvel et al. disclose further comprising:

Second and third decoding means (111) for picking up message data which are classified into a hierarchical structure and transmitted to own address (column 5 lines 49 to 54);

Hierarchy associated storing means for storing the message data which are picked up by the second and third decoding means every hierarchy (column 1 lines 44 to 52); and

Wherein erasure of the message is effected by the hierarchy setting means and the time counting means (column 6 lines 45 to 53).

Claims 9, 11-14 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanden Heuvel et al. (US# 5426,424) in view of Helferich (US# 6,259,892) as applied to claims 7, above, and further in view of Murai (US# 5,239,679.)

Referring to claim 9, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver according to any one of claim 7. However, Vanden Heuvel in view of Helferich did not clearly disclose further comprising: time setting means for inputting times as timings for erasure



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of the messages by a user; and time monitoring means for monitoring whether or not a time coincides with an input times; wherein the erasure of the messages is effected periodically at respective times which are input by the user.

In the same field of endeavor of selective call receiver, Murai teaches that time setting means (12) and day-of-the-week means for inputting times as timings for erasure of the messages by a user (column 5 lines 11 to 15); and

time monitoring means and day-of-the-week means for monitoring whether or not a time coincides with an input times (column 3 lines 12 to 19);

Wherein the erasure of the messages is effected periodically at respective times which are input by the user (column 3 lines 20 to 27) for the purpose of erasing the stored messages which are several weeks old in memory and display only the current new messages (column 2 lines 24 to 37).

One skill in the art would have recognized the need to modify the timer and time setting circuit of Murai to the selective call receiver of Vanden Heuvel et al. in view of Helferich because Vanden Heuvel et al. suggests that the need to modify a time that set by a user to delete old messages in the memory is so desired and Murai teaches that the time measured by the timer circuit becomes identical to the message-erasing timing set by operating the input section, the message-erasing circuit automatically erases the message stored in said memory circuit (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the timer circuit of Murai into the selective call receiver of Vanden Heuvel et al. in view of Helferich with the motivation being to provide a

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selective call receiver capable of erasing the messages at programmable intervals that is set by users.

Referring to claims 11-14 and 25-28, Vanden Heuvel et al. in view of Helferich disclose a radio paging receiver, to the extent as claimed with respect to claims 7-10 above, however, Vanden Heuvel in view of Helferich did not clearly disclose wherein the messages are erased collectively concerned messages.

In the same field of endeavor of selective call receiver, Murai teaches that the messages are erased collectively concerned messages (column 3 lines 43 to 55) for the purpose of erasing the selectively stored messages.

One skill in the art would have recognized the need to modify the way to erase the messages in memory selectively by using the input section of Murai to the selective call receiver of Vanden Heuvel et al. in view of Helferich because Vanden Heuvel et al. suggests that the need to erase the messages in memory selectively is so desired and Murai teaches that pager holder has preset the message-erasing time of "00:00," all message codes stored in the message memory, except for those containing a data-preserving flag, are automatically erased at the preset message-erasing time (column 10 lines 21 to 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the way to erase the messages in memory selectively by using the input section of Murai into the selective call receiver of Vanden Heuvel et al. in view of Helferich with the motivation that a selective call receiver capable of erasing the collectively concerned messages of the user choice and providing the memory has more space to store other messages.

***Allowable Subject Matter***

Claims 1-6 and 15-20 are allowed as evident by applicant's arguments.

Referring to claims 1 and 15, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that first controlling means for causing the erasing means to erase concerned messages when it is detected by the character sequence retrieving means that the designated character sequences are contained in the stored messages and it is detected by the time counting means that the predetermined time has lapsed after the messages are stored.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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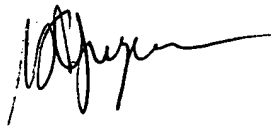
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 703-305-3867. The examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nam Nguyen  
April 4, 2003



MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
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